

REMARKS

Claims 1-18 and 25-32 are presented for examination. Claims 1-18 are withdrawn. Claims 25-32 are pending.

Claims 25-32 stand rejected only under 35 U.S.C. 112, first paragraph, as not being enabled.

Claims Rejections – 35 U.S.C. 112, first paragraph, Enablement

Claims 25-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The rejection states that the specification does not reasonably provide enablement for the product to be more sticky to the function of time. The Examiner's rejection has been carefully considered.

Applicant argues that the present claims are fully enabled by the specification as filed. Furthermore, the Examiner is on record as indicating that no undue experimentation would be required by one skilled in the art to make and use the present invention.

The claims are not broad or unclear with respect to the recited composition being sticky (adhesive) upon application and becoming less sticky over time. In the rejection and regarding the breadth of the claims, the Examiner asserts:

"The claims are broad and unclear as the composition is more sticky when initially applied and what is the time interval that the composition becomes less sticky, and how the composition becomes less sticky."

It appears that the Examiner is indicating that the scope of the claims is broad and that the meaning of the claims is unclear with respect to the recited composition being sticky (adhesive) upon application and becoming less sticky over time and the process by which this occurs. It is not clear if the Examiner is indicating that the range of stickiness is broad and/or if the time interval over which the hair wax composition becomes less sticky is broad. With respect to the scope of stickiness, the range of stickiness for hair styling products is necessarily limited by the nature of fixing hair. With respect to the time interval over which the hair wax composition becomes less sticky, claim 28 recites "*within an initial time interval immediately after the applying of step b),*" which clearly indicates a short time span as is customary for hair-styling compositions. Claim 29 further limits the time interval to between 20 and 30 seconds. Regarding the mechanism by which the composition becomes less sticky, page 6, lines 12-17 clearly indicate that the duration of the adhesive (sticky) phase and the residual stickiness can be adjusted by varying the amount of alcohol in the composition.

The specification provides guidance with respect to how one skilled in the art is to make a hair wax composition that is sticky (adhesive) upon application and becomes less sticky over time. In the rejection and regarding the predictability or unpredictability in the art, the Examiner asserts:

"...the specification does not provide guidance as how one skilled in the art would accomplish the objective of the composition being more sticky than during a time after said initial time interval. Nor is there any guidance provided as to a specific protocol to be utilized in order to show the efficacy of the presently claimed active ingredients to be more sticky or less sticky due to the function of time;"

"...support for unpredictability of the composition being more sticky than during a time after said initial time interval is supported by the references Patent No. 4970067 and 6294159;"

“No experimental evidence or mechanism of action for supporting the composition applied to the hair is more sticky than during a time after said initial time interval using the specified actives by simply administering, by any method, an amount of the claim specified active ingredients;” and

“The specification is viewed as lacking an adequate enablement of where the hair wax composition applied to the hair is more sticky than during a time after said initial time interval.”

The Examiner asserts that the specification provides no guidance with regard to how to accomplish the objective of the hair wax composition, cites the lack of a protocol to be used to show efficacy of the “active ingredients,” lack of experimental proof, and indicates unpredictability in the art. In other words, the Examiner doubts the truth or accuracy of Applicant’s statement in the specification that the hair wax recited in the claims is sticky upon application and becomes less sticky with time.

MPEP 2164.4 states:

“A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.”

“In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In re Wright, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure).”

"In reMarzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439 F.2d at 224, 169 USPQ at 370."

The present specification provides ample guidance with respect to the identities and amounts of the constituents of the hair wax composition recited in the claims, as well as delivery vehicles for the hair wax composition. The specification clearly discloses that the hair wax compositions described possess the property of being more adhesive (sticky) upon application and become less sticky over time as alcohol evaporates from the composition.

The Examiner has provided no reason whatsoever for doubting that the hair wax compositions recited in the present claims have the properties ascribed to them in the specification and claims, other than a general reference to unpredictability in the art. The Examiner, however, in the rejection of claims under 35 U.S.C. 103(a) in the Office Action mailed 11/28/2007 states:

"Therefore, one of ordinary skill in the art would have been motivated to use the teachings of the above mentioned references and produce a hair wax for styling and restyling of the hair which is more sticky in the temporary phase, which is an obvious characteristic of many hair wax or hair gel products. Upon application most gels are more sticky and gradually after application the stickiness is decreased, as described by Carballada et al. the composition does not feel sticky or stiff after it has been applied to hair."

In making the rejection under 35 U.S.C. 103(a), **the Examiner asserts that being more sticky in the temporary phase for a hair wax "is an obvious**

characteristic” but now asserts that the same claimed invention is not enabled for having the **very same characteristic**, in part, because of unpredictability in the art regarding hair wax compositions. Clearly, and by the Examiner's own admission, there is no reason to doubt that the hair wax compositions recited in the present claims have the characteristic of being sticky upon application and becoming less sticky over time.

In view of the foregoing arguments, Applicant respectfully requests that the rejection of claims 25-32 under 35 U.S.C. 112, first paragraph, be withdrawn.

Conclusion

The application in its amended state is believed to be in condition for allowance. Action to this end is courteously solicited. Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully Submitted,



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